



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAME	INVENTOR	ATTORNEY DOCKET NO.
077753, 033	09/20/91	ZAPLER		GY20A

SEEN, C.	EXAMINER
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ART UNIT	PAPER NUMBER
1202	3

DATE FILED: 02/28/92

U.S. PATENT AND TRADEMARK OFFICE
COMMUNICATIONS SECTION

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice re Patent Drawing, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449. *6 sheets*
- ☐ Notice of Informal Patent Application, Form PTO-152
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐ _____

Part II SUMMARY OF ACTION

- ☒ Claims 1-22 are pending in the application.
Of the above, claims 9-14, 16-19, 21 and 22 are withdrawn from consideration.
- ☐ Claims _____ have been cancelled.
- ☐ Claims _____ are allowed.
- ☒ Claims 1-6 are rejected.
- ☒ Claims 7, 8, 15 and 20 are objected to.
- ☒ Claims 1-22 are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
- ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

EXAMINER'S ACTION

Art Unit 1202

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-6 (part of each), 7, 8, 15 and 20, drawn to hydroxymethyl (methylenecyclopentyl) purines, classified in Class 544, subclasses 254, 264, 265, 276, 277.

II. Claims 1-6 (part of each), 9-14, 16-19, 21 and 22, drawn to hydroxy methyl (methylene cyclopentyl) pyrimidines, classified in Class 544, subclasses 310, 317.

Claims 1-6 link inventions I and II.

The inventions are distinct, each from the other because of the following reasons:

Hydroxy methyl (methylene cyclopentyl) purines differ significantly from hydroxy methyl (methylene cyclopentyl) pyrimidines in Chemical structure.

They are differently classified.

One of ordinary skill in the art would not treat such diverse structures as functional equivalents of each other. Daluge ('671), Bisacchi et al. ('961) do not consider them equivalent.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit 1202

During a telephone conversation with Mr. Davis on Feb. 12, 1992 a provisional election was made with traverse to prosecute the invention of I, claims 1-8, 15 and 20. Affirmation of this election must be made by applicant in responding to this Office action. Claims 9-14, 16-19, 21 and 22 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. Traverse may be perfected by filing written reasons.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Claims 1-6 are rejected under judicial created doctrine as drawn to improper Markush groups. The reasons for restriction requirement are incorporated herewith. The cited prior art does not recognize the equivalency. In re Winnek 73 USPQ 225.

Claims 7, 8, 15 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Art Unit 1202

The instantly claimed 2-methylene-cyclopentyl derivatives are not taught/suggested by the prior art. References are cited for the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tsang whose telephone number is (703) 308-4715.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Tsang: ach
February 27, 1992

C Tsang
CECILIA ~~TSANG~~
PRIMARY EXAMINER
ART UNIT 1202